

III. REMARKS

1. Claim 23 is amended to address the 35 USC §101 rejection.
2. Claims 1-3, 7-8, 13-16, 19-21 and 23 are not unpatentable over Tanaka in view of Veerasamy and Marwell under 35 USC §103(a).

Tanaka does not disclose or suggest creating a collection of selected geographical positions using a mobile terminal as is claimed by Applicant. Tanaka, in Col. 3, lines 11-20, discloses a "search list." The "search list" is an alphabet-based list that allows a user to search for a "target location." This is beneficial in the navigation system of Tanaka that includes a map displaying the present location and travel route guidance. The "search list" is used in guiding the travel route. There is no disclosure or suggestion in Tanaka related to "creating a collection of selected geographical positions using a mobile terminal" as is claimed by Applicant.

Tanaka refers to registering a new location. To register a new location, in Tanaka, the user "manipulates the operation switches 7" to specify the new location "on the map displayed by the display unit 9. This specified location is registered as a memory location." (Col. 3, lines 20-25). This is not the same as what is claimed by Applicant where the current geographical location is "automatically" obtaining or determined and stored.

Although Tanaka can determine its current position, there is no disclosure related to creating a collection of selected geographical positions using a mobile terminal as is recited by Applicant in the claims.

Veerasamy does not overcome at least this deficiency. Veerasamy discloses determining and storing the current mobile station position information when a call is dropped. There is no disclosure related to creating a collection of selected geographical positions as is claimed by Applicant. Thus, combining Veerasamy with Tanaka cannot disclose or suggest at least this feature.

Combining Marwell with Veerasamy with Tanaka also does not disclose at least this feature. Marwell is a personalized directory assistance system and is directed to populating and maintaining a list of personal contact data. There is no disclosure in Marwell related to determining a current geographical location of the mobile station and creating a list of geographical positions as is claimed by Applicant.

Claims 14 and 23 recite similar subject matter and are equally not unpatentable. Claims 2, 3, 7, 8, 13, 15-16, and 19-21 are not unpatentable at least by reason of their respective dependencies.

Additionally, it is respectfully submitted that there is no motivation to combined Tanaka, Veerasamy and Marwell, and these references have been improperly combined.

There is no motivation to combine Tanaka, Veerasamy and Marwell because one of skill in the art would not look from a system capable of registering new locations to a system for identifying coverage holes in a wireless network to a personalized assistance system to achieve what is claimed by Applicant. Although the motivational requirements with respect to obviousness have been altered under *KSR*, there must still be an explicit reason to combine or modify the subject references. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit. The Court, quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 82 USPQ2d at 1396 (MPEP 2141). The Examiner states that motivation to combine the references is to "provide an efficient geographical navigation system." It is respectfully submitted that this reasoning is merely a broadbased, conclusory statement, without any factual support, since only Tanaka relates to geographical navigation.

Tanaka is a navigation system that stores data on a plurality of locations and searches the memory for a target location in route guidance. Differently, Veerasamy provides a system for reporting "call drop." Although Veerasamy includes a GPS device, that is the only similarity between these two references. Veerasamy is not concerned with "efficient geographical navigation." Rather, it is specific to identifying problem locations in a wireless network. Thus, one of skill in the art would not look from Tanaka to Veerasamy to provide a more "efficient geographical navigation system" since Veerasamy is not related to geographical navigation.

Marwell is a personalized directory assistance system. The user speaks with a customer service representative by dialing a number on the phone. Marwell has nothing to do with navigation or geographical locations. Thus, one of skill in the art would not have any reason to look to Marwell for the purpose of developing a more "efficient geographical navigation system."

Therefore, there is no motivation to combine Tanaka, Veerasamy and Marwell as alleged by the Examiner, and a *prima facie* case of obviousness pursuant to 35 USC §103(a) cannot be established.

It is also respectfully submitted that Tanaka, Veerasamy and Marwell have not been properly combined because if Tanaka were able to modified by Veerasamy and Marwell, Tanaka would no longer be fit for its intended purpose. If a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)" (see MPEP §2143.01). Tanaka is directed to storing data of a plurality of locations and searching for target locations. Modifying Tanaka with a system that identifies drop call locations would only add another reason to store data on a drop call location. However, Tanaka is directed

to navigation, where Veerasamy is not. Any modification of Tanaka with Veerasamy could only be with extensive experimentation, and would alter the intended use of Tanaka.

Marwell provides for personalized directory assistance where the user calls a given number. Modifying Tanaka to include a personalized directory assistance system such as that of Marwell renders Tanaka unfit for its intended purpose, if the references could be combined at all. The proposed modification would render Tanaka unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Therefore, a *prima facie* case of obviousness under 35 USC §103(a) cannot be established.

Additionally, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)" (see MPEP §2143.01). It is submitted that modifying Tanaka with Veerasamy and Marwell would change the principle operation of Tanaka for reasons substantially similar to those described above.

Thus, it is respectfully submitted that each of the requirements to establish a *prima facie* case of obviousness, are not, and cannot be established.

3. Claims 5, 6, 12, 17-18, 22 and 24-27 are not unpatentable over Tanaka in view of Veerasamy and Marwell and well known prior art under 35 USC §103(a) at least by reason of their dependencies.

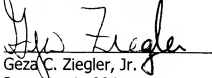
4. Claims 9–11 are not unpatentable over Tanaka in view of Veerasamy and Marwell and Najafi under 35 USC §103(a) at least by reason of their respective dependencies.

Additionally, neither Tanaka nor Najafi are analogous art and cannot be combined for purposes of 35 USC 103(a) when applying the reasoning noted above. Applicants claimed subject matter is directed to creating a collection of selected geographical positions have been visited by the device. Neither Tanaka nor Najafi are directed towards what is claimed by Applicant. Tanaka relates to a navigation system for a vehicle. Najafi is a wireless phone having an emergency beacon. Applicant's claimed subject matter provides the advantage that the exact position of the device can be mapped (determined and stored) with a single operation (single key activation). Neither Tanaka nor Najafi is concerned with the particular problems that applicant's claims subject matter seeks to address. Therefore, the references are not analogous art and cannot be combined for purposes of 35 USC §103(a) for the reasons stated above.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



Geza C. Ziegler, Jr.
Reg. No. 44,004
Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

8 June 2009
Date